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In re Application of
Gary Ruvkun et al
Serial No.: 08/908,453
Filed: August 7, 1997
Attorney Docket No.: 08472/704002

: PETITION DECISION

This is in response to the petition under 37 CFR 1.181, filed October 14, 2004, requesting withdrawal of the Final Office action.

BACKGROUND

A review of the file history shows that the examiner mailed a Final Office action to applicants on June 10, 2003, and remailed the Office action, resetting the three month shortened statutory period for reply, on July 8, 2003. Applicants replied to this Office action on November 12, 2003, with an argument with respect to the outstanding rejections. It appears that no Advisory Action in response to the reply was mailed by the examiner to applicants. Applicants filed a Notice of Appeal on December 30, 2003. Applicants then filed a new reply to the Office action on June 4, 2004, accompanied by an Appeal Brief. A Notice of Defective Appeal Brief was mailed to applicants on September 9, 2004, and a new Appeal Brief was filed on October 14, 2004, accompanied by the instant petition.

DISCUSSION

The Final Office action remailed July 8, 2003, was in reply to a first Appeal Brief filed November 13, 2002. The Final Office action contains a new ground of rejection based on Swinburne et al provided in an IDS filed by applicants on August 15, 2002. Applicants reply to the Final Office action filed November 12, 2003, responds to the rejection, but makes no mention of the finality of the Office action being premature. Applicants' Notice of Appeal, filed December 30, 2003, makes no mention of the Final Office action being premature. On June 4, in a supplemental reply to the Office action mailed 11 months earlier, applicants first raise the issue of the Final Office action being premature, concurrently with the filing of an Appeal Brief. The reply is not in the form of a petition. The Appeal Brief also contains an argument that the finality of the rejection is premature.

The Appeal Brief was held to be non-compliant in a letter mailed to applicants on September 9, 2004. On October 14, a new Appeal Brief was filed and this petition. The petition states that a

procedural error has occurred in that the finality of the Office action of July 8, 2003 was premature in that the rejection was based on a reference supplied in an IDS by applicants under 37 CFR 1.97(d) and (e). The examiner in the Office action stated that the reference being applied was filed under 37 CFR 1.97(c). 37 CFR 1.97(c) notes that an IDS filed after close of prosecution (e.g. by Final Office action, allowance, etc.,) will not be considered unless accompanied by a fee and a statement specified by 37 CFR 1.97(e). **37 CFR 1.97(d) relates to consideration of an IDS filed after a Notice of Allowance and before the payment of the Issue Fee.** As this application has never been allowed and No Notice of Allowance and Issue Fee Due has been mailed, 37 CFR 1.97(d) does not apply. It is clear, however, that 37 CFR 1.97(c) does apply in that the IDS, while initially filed during a time when prosecution was closed in the application, the withdrawal of the finality of a previous Final Office action, as stated in the first part of the Office action of July 8, 2003, permitted the reference to become available under 37 CFR 1.97(c). In view thereof the finality of the Office action of July 8, 2003, was not premature. (It is also noted that the proposed rejection was discussed telephonically with applicants by the examiner prior to the Office action issuing.)

Further, a request to withdraw an improper Office action by an examiner under 37 CFR 1.181 must be filed within two months of the action complained of (37 CFR 1.181(f)). Such appears not to be the case here. The request to have the Final Office action withdrawn was not made in the response filed November 12, 2004, as it should have been, but appears to have first been filed almost eight months after that response and six months after filing a Notice of Appeal and is untimely.

The petition is **DENIED** for all of the above reasons.

The application will be forwarded to the examiner for further consideration.

Should there be any questions about this decision please contact William R. Dixon, Jr., by letter addressed to Director, TC 1600, at the address listed above, or by telephone at 571-272-0519 or by facsimile sent to the general Office facsimile number, 571-273-8300.

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